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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------------|-----------------------------|
| 10/039,481 | 01/08/2002 | Yaacov Almog | 600204464-9 | 1737 |
| 22879 7590 09/01/2010 HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528 | | | EXAMINER RODÉE, CHRISTOPHER D | |
| | | | ART UNIT 1795 | PAPER NUMBER |
| | | | NOTIFICATION DATE 09/01/2010 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YAACOV ALMOG

Appeal 2010-002842
Application 10/039,481
Technology Center 1700

Before BRADLEY R. GARRIS, ADRIENE LEPIANE HANLON, and
CHARLES F. WARREN, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellant appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 47, 51-58, 63, and 65-74. We have jurisdiction under 35 U.S.C. § 6.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellant claims an electrostatic imaging process which uses liquid toners (claim 47) and liquid toners for such a process (claim 63), wherein the liquid toner comprises a charge director and toner particles comprising a pigmented polymer which is unchargeable or weakly chargeable by the charge director and wherein the particles are coated with an ionomer which increases the chargeability of the particles to greater than 7 pmho/cm.

Further details regarding the Appellant's claimed subject matter are set forth in representative claims 47, 70, and 71:

47. An electrostatic imaging process comprising:

(A) forming a charged latent electrostatic image on a photoconductive surface; and

(B) applying to the photoconductive surface toner particles from a liquid toner, thereby forming an image, wherein the liquid toner comprises:

- (a) an insulating non-polar carrier liquid;
- (b) at least one charge director; and
- (c) toner particles dispersed in the carrier liquid and the at least one charge director, the particles comprising:
 - (i) a core material comprising a pigmented polymer suitable for use as a toner material in an electrostatic image development application, which is unchargeable by the at least one charge director or which is weakly chargeable by the at least one charge director;
 - (ii) a coating of at least one ionomer component in an amount effective to impart an enhanced chargeability to the toner particles to an extent that the particles can be used to develop a latent electrostatic image in the electrostatic image development application; and

(iii) wherein the coating of the at least one ionomer increases the chargeability of the toner particles to greater than 7 pmho/cm.

70. The electrostatic imaging process of Claim 47 wherein the coating of the at least one ionomer increases the chargeability of the toner particles by at least 15 pmho/cm.

71. The electrostatic imaging process of Claim 47 wherein the coating of the at least one ionomer increases the chargeability of the toner particles by 15 to 161 pmho/cm.

The Examiner rejects all appealed claims under the first paragraph of 35 U.S.C. § 112 for failing to comply with the written description requirement (Answer 3-5).

We will sustain this rejection for the reasons well stated by the Examiner in the Answer (*id.* at 3-11). We add the following comments for emphasis.

The test for compliance with the written description requirement is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). Because a patent is not a reward for the search but compensation for its successful conclusion, requiring a written description of the invention limits patent protection to those who actually perform the difficult work of "invention"-that is, conceive of the complete and final invention with all of its claimed limitations-and disclose the fruits of that effort to the public. *Id.*, 598 F.3d at 1353.

For the reasons detailed in the Answer, Appellant's Specification disclosure would not reasonably convey to those skilled in the art that

Appellant had possession of the representative claim 47 limitation of increasing the chargeability of weakly chargeable and especially unchargeable particles to a range "greater than 7 pmho/cm." As correctly pointed out by the Examiner, this range includes an undisclosed lower limit of slightly greater than 7 (e.g., 7.01) and an undisclosed upper limit which has no boundary (Ans. 4). Likewise, the Specification would not convey possession of the representative claim 70 range of "at least 15 pmho/cm" since this range includes an unbounded upper limit which has not been disclosed for either unchargeable or weakly chargeable particles and a lower limit which has not been disclosed for unchargeable particles. Finally, the Examiner correctly determines that the Specification would not convey possession of the numerical range defined by representative claim 71 or the similar numerical ranges defined by claims 72-74 because the ranges are undisclosed with respect to the unchargeable-particles embodiment encompassed by these claims.

Concerning the lower limit of the claim 47 range, Appellant argues that "no requirement exists for the specification to disclose a specific value of just greater than 7 pmho/cm" (App. Br. 9). Appellant is incorrect. The written description requirement of § 112 requires the Specification disclosure to convey that Appellant had possession of this lower limit value. For the reasons given by the Examiner, Appellant's Specification fails to convey such possession. Indeed, no Specification disclosure has been identified by Appellant which would convey to those skilled in the art that the lower limit value would be even capable of performing the electrostatic imaging function required by the appealed claims.

As for the unbounded upper limit of the claim 47 range, Appellant concedes that an actual upper boundary for particle conductivity might exist (*id.* at 10). Nevertheless, Appellant argues that "[n]o requirement exists for Appellant to identify all possible combinations of ionomer, particle, charge director, etc. compositions and determine which has the highest theoretical upper boundary for particle conductivity merely to state a bounded upper range in the claims" (*id.* at 11). Appellant again is incorrect for reasons analogous to those set forth above and in the Answer.

Appellant further argues that "the broad disclosure of the specification clearly encompasses any amount of chargeability enhancement of the claimed toner particles, whether unchargeable or weakly chargeable" (Reply Br. para. bridging 4-5). According to Appellant, "[s]ince the specification broadly discloses any increase, it follows that Appellant may properly narrow the range to encompass the subset including an increase to greater than 7 pmho/cm, consistent with the examples" (*id.* at 6). Contrary to Appellant's belief, a broad disclosure does not necessarily provide written description support for more narrow subject matter. *See In re Smith*, 458 F.2d 1389, 1395 (CCPA 1972) (narrow claims were properly determined to lack descriptive support even assuming broader claims would have been descriptively supported). This is because the written description requirement limits patent protection to those who actually conceive of the complete and final invention with all its claimed limitations and disclose the fruits of that effort to the public. *Ariad*, 598 F.3d at 1353.

Finally, for the reasons given by the Examiner and based on the legal rationale set forth above, we perceive no convincing merit in Appellant's

arguments concerning the range limitations of representative claims 70 and 71 (as well as claims 72-74).

In light of the foregoing, we sustain the Examiner's rejection of all appealed claims as failing to comply with the written description requirement in the first paragraph of § 112.

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (2008).

AFFIRMED

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